Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON M. BREWER

Appeal No. 2001-0530
Application No. 08/828,484

ON BRIEF

Before JERRY SMITH, DIXON, and LEVY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6 and 8-35, which are all of the claims pending in this application. Claims 7 and 36 have been canceled. The examiner has withdrawn the rejection under 35 USC § 112, first paragraph.

We REVERSE.

BACKGROUND

Appellant's invention relates to an interconnected ethernet and 1394 network where the gateway computer also functions as a host computer. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A network configuration, comprising:

a first 1394 network medium;

a plurality of host computers coupled to the first network medium;

a second network medium;

a plurality of host computers coupled to the second network medium;

a link layer gateway computer coupled to the first network medium and coupled to the second network medium; said link gateway computer operable to communicate a data packet from a source host computer selected from one of the plurality of host computers coupled to the first network medium to a destination host computer selected from one of the plurality of host computers coupled to the second network medium, said link layer gateway computer operable to communicate a data packet from a source host computer selected from one of the plurality of host computers coupled to the second network medium to a destination host computer selected from one of the plurality of host computers coupled to the first network medium, said link layer gateway computer determining whether said data packet is addressed to a host computer, on said first or second network medium; and blocking transmission of said data packet through said link layer gateway computer if said data packet is addressed to a host computer in the same network medium;

determining at said gateway computer whether said data packet is addressed to said gateway computer; and

responsive to a positive determination, communicating between said source host and said gateway computer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Perlman et al. (Perlman)	5,309,437	May 3, 1994
Okanoue et al (Okanoue)	5,452,292	Sep. 19, 1995

Claims 1-6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okanoue.[1] Claims 9-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okanoue in view of Perlman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed Nov. 10, 1999) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 9, filed Aug. 9, 1999) and reply brief (Paper No. 11, filed Dec. 2, 1999) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the

[1] We note that the rejection is over Okanoue alone, but the examiner has parenthetically cited to Iwamura and Fukuzawa with respect to claims 1 and 3. This is an improper reliance upon an reference which has not been properly applied, and we will limit our consideration to Okanoue alone. A similar issue is present with respect to claim 17 in the combination of Okanoue and Perlman. We will limit our consideration to the combination of Okanoue and Perlman.

respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

"To reject claims in an application under section 103, an examiner must show an unrebutted ***prima facie*** case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper ***prima facie*** case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of ***prima facie*** obviousness or by rebutting the ***prima facie*** case with evidence of secondary indicia of nonobviousness." **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998). Here, we disagree with the examiner's rejection and find that appellant has overcome the ***prima facie*** case of obviousness by showing insufficient evidence by the examiner in the rejection of the ***prima facie*** case of obviousness which persuades us of the nonobviousness of the claimed invention.

Appellant argues that Okanoue teaches and uses the term "gateway node" in the reference, but the language of independent claim 1 recites "gateway computer." (See brief at pages 5-6.) Appellant argues that there is no correspondence of the node to the gateway computer which is a multifunction computer which is capable of operation

in at least two different modes. (See brief at page 6.) Appellant argues that claim 1 requires that the gateway computer is capable of acting as a host computer. Appellant argues that the gateway computer is (1) capable of communicating directly with a host computer on one of the networks and blocking transmission to the other network; (2) controlling communication between the two networks; and (3) operating on the data at the gateway computer itself. (See brief at page 6.) We agree with appellant, and find no clear teaching or suggestion in Okanoue that the "gateway node" is a host computer. We note that appellant has repeatedly argued this point in the brief, but the examiner has never directly addressed this argument. We note that the rejection has been drafted using the term "gateway computer" throughout, but we find no support that the "gateway node" is a host computer. The examiner cites to column 4 and Figures 2, 9(b) and 10(b) to teach a gateway computer at page 3 of the answer and to columns 6 and 2 for determining whether the data packet is addressed to the gateway computer and communicating between the source host and the gateway computer.[2] From our review of the cited passages and the remainder of the teachings of Okanoue, we find no clear teaching or suggestion that the gateway node is a host computer. The examiner appears to accept this as a given, but we find no support for the examiner's

[2] We note that the language of independent claims 1 and 17 recite multiple "determining" steps or functions and ultimately recite "responsive to a positive determination, communicating between said source host and said gateway computer." Here, we interpret this ultimate limitation to refer to the immediate prior step of "determining at said gateway computer whether said data packet is addressed to said gateway computer."

finding, and the examiner has not directly addressed this issue. The examiner includes two definitions at page 26 of the answer with respect to node and gateway. Here, we note that both definitions refer to "a device" rather than a "computer" or "host computer." Therefore, this argument is not persuasive with respect to the examiner's position that Okanoue teaches a "gateway computer." The examiner's analysis of the disclosure of Okanoue at pages 27-28 of the answer shows that Okanoue teaches a determination of whether the data packet is intended for the same network or a different network and performing blocking when appropriate. We find no teaching of the gateway node acting as a separate host computer and acting on the data packet. Therefore, the examiner's position and argument are not persuasive, and we cannot sustain the rejection of independent claim 1 and its corresponding dependent claims. Accordingly, the rejection of claims 1-6 and 8 under § 103 is reversed. We turn next to the rejection of claims 9-35 under § 103 as unpatentable over Okanoue in view of Perlman.

Our reviewing Court has made it clear in **In re Lee**, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1443 (Fed. Cir. 2002) and **In re Zurko**, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) that rejections must be supported by the administrative record and that where the record is lacking in evidence, this Board cannot and should not resort to unsupported speculation. (**See also, In re Warner**, 379

F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). We cannot sustain the rejection of claims 9-35 because Perlman does not make up for the deficiencies of Okanoue. Accordingly, the rejection of claims 9-35 under § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 and 8-35 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

jld/vsh

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